

REMARKS

At the time of the Third Office Action dated June 12, 2008, claims 1-17 were pending and rejected in this application.

CLAIMS 1, 3, 6, 8-9, 11, 14, AND 16-17 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON BEN-SHAUL ET AL., U.S. PATENT NO. 6,976,090 (HEREINAFTER BEN-SHAUL)

On pages 4-7 of the Second Office Action, the Examiner asserted that Ben-Shaul discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

Applicants incorporate herein, the arguments previously presented on pages 2-7 of the Second Response filed February 21, 2008 (hereinafter the Second Response). Applicants also note the Examiner's additional statements on 2-4 of the Third Office Action.

Specifically, the Examiner asserted the following in the second enumerated paragraph on page 2 of the Third Office Action:

The examiner interprets the claims as follows: when a web page is cached in a proxy server (heretofore known as the client, as distinct from an end user client), it modifies the URLs in the web pages based on some mapping. The examiner interprets "Pathway Navigation Map" broadly as based on associations for any of a variety of navigation purposes, including redirection, associations with nearby hosts in a DNS environment, and interpreting URLs with "query" components.

The Examiner's assertion that a proxy server corresponds to the claimed "client" is a factually-unsupported and unjustified claim construction. During patent examination, the pending claims

must be "given their broadest reasonable interpretation consistent with the specification,"¹ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.² Therefore, although the Examiner may construe a claim broadly, this claim construction cannot be inconsistent with Applicants' specification or inconsistent with the interpretation that those skilled in the art would reach.

A proxy server, is a server that serves as a proxy (i.e., in the place of) as another server. Therefore, one having ordinary skill in the art would deem a proxy server as broadly disclosing a server. However, one having ordinary skill in the art would necessarily recognize a difference between a client, as claimed, and a server, as disclosed by Ben-Shaul. The differences and relationships between a client and a server is one of the most basic concepts of distributed computing. Applicants are entirely unclear how the Examiner can assert that one having ordinary skill in the art would reasonably believe that a proxy server identically discloses a client. As such, based upon this limitation, the Examiner has failed to establish that Ben-Shaul identically discloses the claimed invention. Although certain of these arguments were already presented in the first full paragraph on page 6 of the Second Response, the Examiner did not address this arguments.

Regarding the Examiner's interpretation of "pathway navigation map," Applicants note that the pathway navigation map is "for said served content." Thus, the Examiner's interpretation must be consistent with the context in which this phrase was used. However, as best can be determined from the Examiner's both ambiguous and factually-unsupported claim construction,

¹ In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

² In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

the Examiner has not addressed this issue. Applicants are also unclear as to the exact feature, within Ben-Shaul, that the Examiner alleges identically discloses the claimed pathway navigation map. On page 4 of the Third Office Action with regard to the claimed "generating a pathway navigation map" step, the Examiner cited nearly 4 entire columns of text. Applicants' position is that if the Examiner cannot identify this claimed step, within Ben-Shaul, with a greater specificity than 4 columns, then the Examiner does not truly know how Ben-Shaul allegedly teaches this step.

In the third through fifth enumerated paragraphs on pages 2 and 3 of the Third Office Action, the Examiner further asserted the following:

The examiner interprets the query component as the endpoint directive to focus on. Interpreting the term "annotating said served content" as changing part of the web page by adding or replacing content, the key to the endpoint directive is that it modify the behavior of a URL in a cached web page. A query expansion appends to the URL a parameter that affects clicking on the hyperlink such that the resulting page changes due to the proper values (col. 40, lines 30-55). Since "hyperlink behavior" is itself a broad term, the fact that a page may be updatable due to the query component is sufficient to fulfill the basis.

In the alternative, URL swapping may also fit the definition as laid above. This is a replacement of terms rather than an addition, but it still fulfills the step of annotation. Here, the URL is replaced for the purpose of redirection, i.e. to a local server or to a particular location on the origin server (col. 39, line 55 — col. 40, line 30). This modifies hyperlink behavior, in the form of changing the address as to which the next content is retrieved.

In both cases, the primary behavior of the modification is to point the hyperlink to either a currently loaded page (page in cache, page in local server) or to a parent page (correct URL to point to origin server). Thus, claim 3 is also fulfilled.

The Examiner appears to forget the actual language of the claim, which recites "annotating said served content with endpoint directives."

As discussed in column 40, lines 37-46, query expansion is just another form of URL swapping. With URL swapping, a source URL is mapped to a destination URL. The edge server, upon receiving a request, determines if the request involves a source URL. If so, the edge server 85 replaces the original URL request with a request for the destination URL. A query

expansion follows this same type of process and includes the extra step of the edge server supplying additional values with the swapped destination URL.

Notably absent from these teachings is any mention of annotating served content. This is to be expected since the proxy server is not responding to served content, but instead, to a request from a client. Thus, even if Ben-Shaul taught annotating the request, the claimed limitation would not be met since a request does not correspond to the claimed served content.

The Examiner's assertion regarding "the primary behavior of the modification" is not relevant. Whether or not certain teachings of Ben-Shaul could be considered as a functional equivalent of the claimed limitations does not establish that Ben-Shaul identically discloses a particular limitation. A rejection under 35 U.S.C. § 102 requires identical disclosure, not equivalent disclosure. By analogy, one could place one's shoe on top of one's head and assert that it is a functional equivalent of a hat (i.e., a piece of apparel that covers the head). However, one skilled in the art would not consider a shoe as identically disclosing a hat. Thus, the Examiner has failed to establish that Ben-Shaul identically discloses the claimed invention within the meaning of 35 U.S.C. § 102.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 1, 4, 6, 8-9, 11, 14, and 16-17 under 35 U.S.C. § 102 for anticipation based upon Ben-Shaul is not viable and, hence, solicit withdrawal thereof.

CLAIMS 2, 4-5, 7, 10, 12-13, AND 15 ARE REJECTED UNDER 35 U.S.C. § 103 FOR

OBVIOUSNESS BASED UPON BEN-SHAUL IN VIEW OF MASLOV, U.S. PATENT NO. 6,842,755

On pages 3 of the Third Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Ben-Shaul in view of Maslov to arrive at the claimed invention. This rejection is respectfully traversed.

Applicants incorporate herein, the arguments previously presented on pages 7 and 8 of the Second Response. In response to these arguments, the Examiner asserted the following in the seventh enumerated paragraph on pages 3 and 4 of the Third Office Action.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the fact that Ben-Shaul and Maslov are interested in the same problem is an indicator that Maslov will improve Ben-Shaul in a way that is desired. One cannot presume that a person of ordinary skill in the art, having found a single solution to his problem, would not seek out other solutions to the problem in the hope of combining elements with predictable results. At the very least, searching out improvements to Ben-Shaul would be obvious to try.

The Examiner's analysis does not reflect common sense employed one having ordinary skill in the art. As already noted in the Second Response, one having ordinary skill in the art would not have been realistically impelled to modify Ben-Shaul in view of Maslov.³ The problem allegedly solved by Maslov has already been addressed by Ben-Shaul, and it is common sense not to solve the same problem twice.

The Examiner's assertion that "[o]ne cannot presume that a person of ordinary skill in the art, having found a single solution to his problem, would not seek out other solutions to the

³ See the non-precedential opinion of *Ex parte Rinkevich*, Appeal 2007-1317 ("we conclude that a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill") (emphasis in original).

problem in the hope of combining elements with predictable results" does not reflect case law or common sense. Unlike a patent examiner, whose goal is to find prior art that tends to show the obviousness of a claimed invention, one having ordinary skill in the art's goal is to simply solve the problem. One having ordinary skill in the art, once solving a problem, does not look to solve the problem again. Instead, one having ordinary skill in the art moves on to the next problem to be solved. Therefore, once provided with the teachings of Ben-Shaul, one having ordinary skill in the art would have no reason to explore the teachings of Maslov if all that is obtained is the solving of the same problem. This is a common sense approach to problem solving.

Regarding the Examiner's "obvious to try" assertion, the Examiner is referred to the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007). Regarding the "obvious to try" rationale, the Guidelines state that the following findings of fact must be articulated by the Examiner:

- (1) a finding that at the time of the invention, there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem;
- (2) a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem;
- (3) a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

These findings of fact, however, were not articulated by the Examiner.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 2, 4-5, 7, 10, 12-13, and 15 under 35 U.S.C. § 103 for obviousness based upon Ben-Shaul view of Maslov is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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